

U.S. Patent No. 6,223,937
Attorney Docket No. 46774-56123
Response to Request for Information

Customer No. 23642
Page 1 of 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. : 6,223,937
Issued : May 1, 2001
Application No. : 09/441,869
Filed : November 17, 1999
For : PORTABLE DISPENSING BOTTLE WITH DISSOLVABLE WAX
PLUG AT INLET

RESPONSE TO REQUEST FOR INFORMATION

Commissioner for Patents
Mail Stop Petitions
P.O. Box 1450
Alexandria, VA 22313-1460

Dear Sir:

In the Request for Information dated September 7, 2011 ("Request"), Petitioner has been asked to address a single question, namely, "[P]etitioner is required to address the point of whether it is reasonable to expect that, at some point during the five year period from May 2005 until June 2010, the patent holder may have performed its own audit to discover the expiration of the patent." Petitioner respectfully submits that it is not reasonable in the particular circumstances presented here to expect Petitioner to take any steps in addition to those taken to ensure timely payment of the maintenance fee and to establish that the entire delay in payment was unavoidable.¹

¹ Petitioner is not aware of any cases requiring a patent owner to independently audit the status of its patents in order to meet the unavoidable delay standard. Nor does the Request cite to any such decision.

U.S. Patent No. 6,223,937
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Page 2 of 3

I. Remarks

As discussed at length in Petitioner's previous submissions,² Petitioner retained a highly sophisticated law firm to track and pay maintenance fees. That firm had been reliable in connection with all patent and trademark matters handled on behalf of Petitioner and the other Harter Entities. The firm utilized docketing and audit procedures that go above and beyond what is required. Petitioner held periodic status meetings with counsel to discuss its intellectual property matters, receive status updates and give instructions to counsel.

In order for Petitioner to have "performed its own audit to discover the expiration of the patent," Petitioner would have to have independently checked the status of its patents on the Patent and Trademark Office website or contacted the Office by other means. However, to require this Petitioner to do so in order to establish that the entire delay was unavoidable would be unreasonable. As stated in the attached Declaration of Joel E. Harter, Petitioner employed no more than 50 employees at any one time during the relevant time period. (Harter Declaration ¶1) Petitioner owned only one patent other than the '937 Patent. (Harter Declaration ¶5) Petitioner has never employed in-house counsel, let alone in-house patent counsel. (Harter Declaration ¶2) Mr. Harter is the person responsible for decisions relating to Petitioner's patent matters. (Harter Declaration ¶3) As stated in Mr. Harter's declaration, he does not know how the status of Petitioner's patents could be determined, other than by asking counsel. (Harter Declaration ¶4) However, as discussed at length in previous filings, Mr. Harter in fact did have regular status calls with counsel to receive updates on the status of Petitioner's patent and trademark matters. It is respectfully submitted that given the relatively small size of Petitioner, its minimal patent holdings and Petitioner's general lack of sophistication with respect to patent matters, it would be unreasonable to expect Petitioner to conduct an independent audit of the status of its patents. These factors are precisely the reasons why Petitioner retained sophisticated counsel to handle these matters. (Harter Declaration ¶5)

² Petitioner incorporates by reference the *Petition to Accept Unavoidably Delayed Payment of Maintenance Fee and for Reinstatement under 37 CFR § 1.378(b)*, the *Response to Request for Information* filed November 23, 2010, the *Petition for Reconsideration under 37 CFR § 1.378(b)* filed June 28, 2011 and the evidence submitted therewith.

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U.S. Patent No. 6,223,937
Attorney Docket No. 46774-56123
Response to Request for Information

Customer No. 23642
Page 3 of 3

II. Conclusion

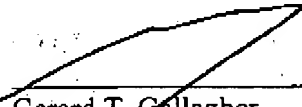
In light of the foregoing, it is respectfully submitted that Petitioner has met its burden of showing that the entire delay in paying the maintenance fees was unavoidable.

III. Authorization to Charge Deposit Account

Please charge the requisite petition fee, and any other fees that are due, to Barnes & Thornburg's Deposit Account No. 100435 (46774.56123).

Respectfully submitted,

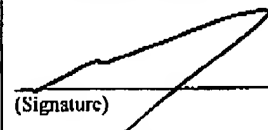
Date: November 7, 2011


Gerard T. Gallagher
Reg. No. 39,679

Certificate Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Office of Petitions), fax number (571) 273-8300

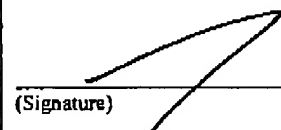
on November 7, 2011


(Signature)
Gerard T. Gallagher
(Printed Name)

Certificate Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as express mail, Express Mail No. ED 369192127 US, in an envelope addressed to Commissioner for Patents, Mail Stop Petitions, P.O. Box 1450, Alexandria, VA 22313-1460

on November 7, 2011


(Signature)
Gerard T. Gallagher
(Printed Name)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 6,223,937
Issued: May 1, 2001
Title: Portable Dispensing Bottle with Dissolvable
Wax Plug at Inlet

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

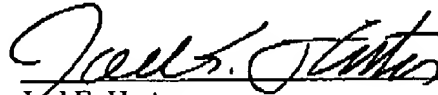
DECLARATION OF JOEL E. HARTER

Sir:

I, Joel E. Harter, hereby declare as follows:

1. During the period May 2005 to June 2010, Petitioner did not employ more than 50 people at any one time.
2. Petitioner has never employed in-house counsel of any kind, including in-house patent counsel.
3. I am the person at Petitioner who is responsible for all decisions relating to Petitioner's patents.
4. Other than inquiring of my counsel at Baker & Daniels, I know of no way to determine the status of patents owned by Petitioner.
5. Petitioner's small size, extremely limited patent holdings (only two during the period from May 2005 to June 2010) and my general lack of knowledge with respect to the patent system are among the reasons why Petitioner retained a large, sophisticated law firm to track and pay patent maintenance fees.
6. The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true;

and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this Declaration and/or the '937 Patent.

Date: 11/7/11

Joel E. Harter
President
Iron Out, Inc.